

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 12

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BRADLEY J. ANDERSON

Appeal No. 98-2158
Application No. 08/610,279¹

ON BRIEF

Before CALVERT, MEISTER, and STAAB, ***Administrative Patent Judges***.

MEISTER, ***Administrative Patent Judge***.

DECISION ON APPEAL

Bradley J. Anderson (the appellant) appeals from the final rejection of claims 1-32, the only claims present in the application.

¹ Application for patent filed March 4, 1996.

We REVERSE and, pursuant to our authority under the provisions of 37 C.F.R. § 1.196(b), we will enter a new rejection of claims 9 and 15 under 35 U.S.C. § 112, second paragraph.

The appellant's invention pertains to a device for sharpening the blade of an ice skate. Independent claim 28 is further illustrative of the appealed subject matter and a copy thereof may be found in the appendix to the brief.

The references relied on by the examiner are:

Scholler 1980	4,219,975	Sep. 2,
Anderson 1995	5,383,307	Jan. 24,

Claims 17-20, 28, 29 and 32 stand rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Anderson.

Claims 1-16, 21-27, 30 and 31 stand rejected under 35 U.S.C.

§ 103(a) as being unpatentable over Anderson in view of Scholler.

The rejections are explained on pages 4 and 5 of the answer. The arguments of the appellant and examiner in support

of their respective positions may be found on pages 8-15 of the brief and pages 6 and 7 of the answer.

OPINION

Considering first the rejection of claims 17-20, 28, 29 and 32 under 35 U.S.C. § 102(b) as being clearly anticipated by Anderson, in setting forth this rejection the examiner states that:

Anderson disclose[s] a skate sharpener (Fig. 16) having generally flat converging lower inside walls, a longitudinal slot, a cylindrical abrasive member, means/holder (131) to retain [the] stone in [the] chamber, and a groove to rotate [the] member.
[Answer, page 4.]

By way of further explanation, the examiner on page 7 of the answer indicates that the recitation of "generally flat" converging side walls "broadly reads on the sharpener of Anderson" and that Anderson shows

a holder (131,132) which has a cavity for abrasive member (130) which is a cylindrical member having abrasive means (127) thereon, and therefore, member (130) is "an abrasive member".

We will not support the examiner's position. Independent claim 17 expressly requires that (1) the body means have "generally flat converging lower inside walls" and (2) "a

cylindrical abrasive member located in said chamber engageable with longitudinal portions of the converging lower inside walls of the body means." As to limitation (1), the body means of Anderson has a lower inside **wall** which is **semi-circular**, rather than lower inside **walls** which are generally **flat and converging** (see Figs. 16 and 18). As to limitation (2), the abrasive member 127 of Anderson is **spaced from** the side wall 121 and thus is engageable with no side wall whatsoever, much less being engageable with longitudinal portions of the converging lower inside walls of the body means as claimed.

Independent claim 28 expressly requires a cylindrical abrasive element and a holder, with the holder having a cavity therein for receiving the cylindrical abrasive element. Apparently the examiner considers Anderson's members 131, 132 to correspond to the claimed holder and Anderson's member 130 to correspond to the cylindrical abrasive element which is received in a cavity in the holder. In Anderson, however, the cylindrical abrasive element is a sleeve 127 which is adhesively secured to the outer circumference of a cylindrical member 130 in such a manner that the ends of the cylindrical

member protrude from the abrasive element or sleeve 127. In order to mount the cylindrical element, these protruding ends are in turn telescopically received in annular bearings 131, 132. While the annular bearings 131, 132 may broadly be considered to be a "holder" for the **cylindrical member**, we do not believe these annular bearings can fairly be construed to be a holder having a cavity to receive the **abrasive element** as claimed.

In view of the foregoing, we will not sustain the rejection of claims 17-20, 28, 29 and 32 under 35 U.S.C. § 102(b) as being clearly anticipated by Anderson.

Turning to the rejection of claims 1-16, 21-27, 30 and 31 under 35 U.S.C. § 103(a) as being unpatentable over Anderson in view of Scholler, the examiner considers that it would have been obvious to form the one-piece sharpener of Anderson of a two-piece construction in view of the teachings of Scholler. Scholler, however, teaches forming the housing of a sharpener of two longitudinally extending halves which are joined together. Recognizing that the claims 1-16 and 21-23 require that first and second sections be joined along transverse or

end walls, the examiner seeks to dismiss this limitation as an obvious variation, which "involves only routine skill in the art." We must point out, however, that there is nothing in the statutes or case law which makes that which is within the capabilities or skill of one skilled in the art synonymous with obviousness. *See Ex parte Gerlach*, 212 USPQ 471 (Bd. App. 1980). Instead, obviousness under § 103 is a legal conclusion based on **factual evidence** (*In re Fine*, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988)) and it is well settled that in order to establish a **prima facie** case of obviousness the prior art teachings must be sufficient to suggest to one of ordinary skill in the art making the modification needed to arrive at the claimed invention (*see, e.g., In re Lalu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1984)). The examiner, however, has provided no factual basis whatsoever for concluding that it would have been obvious to join first and second sections along **transverse or end walls** in the particular manner claimed (which transverse or end walls do not even exist in either Anderson or Scholler). *See, e.g., In re GPAC Inc*, 57 F.3d 1573, 1582, 35 USPQ2d 1116, 1123 (Fed. Cir. 1995) and *In*

re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967),
cert. denied, 389 U.S. 1057 (1968)).

With respect to claims 21-23, 30 and 31 there is nothing in Scholler which would overcome the basic deficiencies of Anderson that we have noted above in the § 102 rejection.

With respect to claims 24-27 there is nothing in the combined teachings of Anderson and Scholler which would fairly suggest a body having first and second sections wherein (1) each section has an inside wall surrounding a chamber and a first end wall closing one end of the chamber and a second transverse end wall open to the chamber and (2) the abrasive member having opposite ends adjacent the end walls of the first and second sections as expressly required by independent claim 24.

For the reasons stated above, we will not sustain the rejection of claims 1-16, 21-27, 30 and 31 under 35 U.S.C. § 103(a) based on the combined teachings of Anderson and Scholler.

Under the provisions of 37 C.F.R. § 1.196(b) we make the following new rejection:

Claims 9 and 15 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellant regards as the invention. In claim 9 the appellant has set forth a pair of longitudinal holes and pins as though they were entirely separate elements when in fact they are a part of the "hole means" and "pin means" previously set forth in parent claim 8. Similarly, in claim 15 the appellant in line 2 sets forth "adjacent ends" as though they were entirely separate elements when in fact they are the "engaging transverse ends" previously set forth in parent claim 12.

In summary:

The examiner's rejections are all reversed.

A new rejection of claims 9 and 15 has been made under 35 U.S.C. § 112, second paragraph.

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 C.F.R. § 1.196(b) provides that, "A new ground of

rejection shall not be considered final for purposes of judicial review."

37 C.F.R. § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

REVERSED
37 C.F.R. § 1.196(b)

IAN A. CALVERT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JAMES M. MEISTER)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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)	
LAWRENCE J. STAAB)	
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JMM/jlb

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